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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,750	04/05/2001	Dwip N. Banerjee	AUS920010175US1	8858
45440	7590	07/08/2005	EXAMINER	
IBM CORPORATION (SS) C/O STREETS & STEELE 13831 NORTHWEST FREEWAY, SUITE 355 HOUSTON, TX 77040			TRAN, QUOC A	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,750

Applicant(s)

BANERJEE ET AL.

Examiner

Quoc A. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to Amendment A, filed 05/03/2005.
2. Claims 1-30 are currently pending in this application. Claims 1, 9, 14, 15, and 23 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-6, 8-20 and 22-30**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cariffe US006561422B1 - filed 05/03/1999 (hereinafter Cariffe), in view of Uekusa et al. US005122953A filed 08/30/1989 (hereinafter Uekusa).

In regard to independent claim 14, **printing an online document to generate an offline document**, (Cariffe at col. 5, lines 45-50, discloses a network to a remote computer, wherein receives the digital document and can manipulate the document using computer applications or print the document using a printer), **inscribing the offline document with one or more editing instructions**, (Cariffe at col. 4, lines 7-17, discloses a method, wherein markings are placed on the original document and the markings can include interlineations, annotations, additions, etc. created during review or proofreading of the original document. Typically, these marks are alphanumeric characters but can also

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be symbols such as mathematical symbols, proofreading marks, shorthand symbols, geometric drawings and lines, foreign language characters and the like. These marks can be added to the original document 100 either manually or by a machine), **scanning the inscribed offline document to create an online version of the inscribed offline document** (Cariffe at col. 2 lines 25-55, discloses a digital scanning device can be used to separate and convert the markings created with the high-contrast marking agent into a digital form. After conversion, the digital information representing the markings can be easily manipulated by computer software applications, such as optical character recognition (OCR) applications, and widely distributed using electronic messaging), **identifying and locating the one or more editing instructions in the online version of the inscribed offline document, executing the one or more editing instructions at the identified locations**, (Cariffe at col. 10 lines 10-19, discloses method for digitally converting markings, comprising: associating original material with an original plane and at least one set of subsequent markings with its own respective distinct plane different from the original plane and other sets of subsequent markings; forming at least one handwritten marking from the at least one set of subsequent markings over the original material located on a media with at least one marking agent; and illuminating each plane with multiple light sources of a detector to cause information associated with each plane to emit radiation at a radiation frequency set that is distinguishable from any radiation frequencies radiated by the other planes and the original plane).

Cariffe does not explicitly teach, **editing instructions selected from a predetermined set of editing symbols**, however (Uekusa at col. 4, lines 17-29, discloses a word processor thus configured can display characters spacing, character arrangement,

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and their printing formats, thus comprising functions of editing character and symbol inputs, editing graphic inputs such as lines, rectangles, circles, ellipses or the like and printing created document data or the like).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Uekusa into Cariffe to provide a way, wherein editing instructions selected from a predetermined set of editing symbols. One of ordinary skill in the art would have been motivated to modify this combination to provide a system, wherein creates handwritten or machine generated subsequent markings on existing documents and accurately and efficiently separates the subsequent markings from the original material and converts at least the subsequent markings into a digital form. The digital form can be computer readable digital information representing the markings (as taught by Cariffe at col. 3, lines 25-65).

In regard to independent claim 9, incorporate substantially similar subject matter as cited in claim 14 above and further view of the following and is similarly rejected along the same rationale, interpreting an online version of a first text image to identify and locate one or more text segments and one or more editing instructions, (Cariffe at col. 10 lines 10-19, discloses a method for digitally converting markings, comprising: associating original material with an original plane and at least one set of subsequent markings with its own respective distinct plane different from the original plane and other sets of subsequent markings; forming at least one handwritten marking from the at least one set of subsequent markings over the original material located on a media with at least one marking agent; and illuminating each plane with multiple light sources of a detector to cause information associated with each plane to

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emit radiation at a radiation frequency set that is distinguishable from any radiation frequencies radiated by the other planes and the original plane), **executing the one or more editing instructions at the identified locations to modify the one or more text segments**, (Cariffe at col. 4, lines 7-17, discloses a method, wherein markings are placed on the original document, wherein markings can include interlineations, annotations, additions, etc. created during review or proofreading of the original document. Typically, these marks are alphanumeric characters but can also be symbols such as mathematical symbols, proofreading marks, shorthand symbols, geometric drawings and lines, foreign language characters and the like. These marks can be added to the original document either manually or by a machine),

Cariffe does not explicitly teach, **editing instructions selected from a predetermined set of editing symbols**, however (Uekusa at col. 4, lines 17-29, discloses a word processor thus configured can display characters spacing, character arrangement, and their printing formats, thus comprising functions of editing character and symbol inputs, editing graphic inputs such as lines, rectangles, circles, ellipses or the like and printing created document data or the like).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Uekusa into Cariffe to provide a way, wherein editing instructions selected from a predetermined set of editing symbols. One of ordinary skill in the art would have been motivated to modify this combination to provide a system, wherein creates handwritten or machine generated subsequent markings on existing documents and accurately and efficiently separates the subsequent markings from the original material and converts at least the subsequent markings into a digital

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form. The digital form can be computer readable digital information representing the markings, (as taught by Cariffe at col. 3, lines 25-65).

In regard to dependent claim 10, creating the first text image by scanning an offline document that has been marked with the one or more editing instructions, (Cariffe at col. 2 lines 25-55, discloses a digital scanning device can be used to separate and convert the markings created with the high-contrast marking agent into a digital form).

In regard to dependent claim 11, preparing an online document incorporating the one or more text segments as modified by the one or more instructions (Cariffe at col. 2 lines 25-55, discloses a method, wherein after conversion, the digital information representing the markings can be easily manipulated by computer software applications, such as optical character recognition (OCR) applications, and widely distributed using electronic messaging).

In regard to dependent claim 12, generating the offline document by printing an online document (Cariffe at col. 5, lines 45-50, discloses a network connected to a remote computer, wherein the remote computer receives the digital document and can manipulate the document using computer applications or print the document using a printer).

In regard to independent claim 1, incorporate substantially similar subject matter as cited in claims 9 and 14 above, and is similarly rejected along the same rationale.

In regard to claims 2, and 8, incorporate substantially similar subject matter as cited in claim 11 above, and are similarly rejected along the same rationale.

In regard to claims 3, and 4, incorporate substantially similar subject matter as cited in claim 9 above, and are similarly rejected along the same rationale.

In regard to dependent claim 5, incorporate substantially similar subject matter as cited in claim 14 above, and is similarly rejected along the same rationale.

In regard to dependent claim 6, further comprising associating the images with the respective anchor points (Cariffe at col. 10 lines 10-19, discloses a method, wherein associating original material with an original plane and at least one set of subsequent markings with its own respective distinct plane different from the original plane and other sets of subsequent markings; forming at least one handwritten marking from the at least one set of subsequent markings over the original material located on a media with at least one marking agent and illuminating each plane with multiple light sources of a detector to cause information associated with each plane to emit radiation at a radiation frequency set that is distinguishable from any radiation frequencies radiated by the other planes and the original plane).

In regard to independent claim 13, wherein the images are inscribed images (Cariffe at col. 4, lines 7-17, discloses a method, wherein markings are placed on the original document and wherein markings can include interlineations, annotations, additions, etc. created during review or proofreading of the original document. Typically, these marks are alphanumeric characters but can also be symbols such as mathematical symbols, proofreading marks, shorthand symbols, geometric drawings and lines, foreign language characters and the like. These marks can be added to the original document either manually or by a machine).

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In regard to independent claim 15, is directed to a system for performing the method of claim 1, and is similarly rejected along the same rationale.

In regard to dependent claim 16, is directed to a system for performing the method of claim 2, and is similarly rejected along the same rationale.

In regard to dependent claim 17, is directed to a system for performing the method of claim 3, and is similarly rejected along the same rationale.

In regard to dependent claim 18, is directed to a system for performing the method of claim 4, and is similarly rejected along the same rationale.

In regard to dependent claim 19, is directed to a system for performing the method of claim 5, and is similarly rejected along the same rationale.

In regard to dependent claim 20, is directed to a system for performing the method of claim 6, and is similarly rejected along the same rationale.

In regard to dependent claim 22, is directed to a system for performing the method of claim 8, and is similarly rejected along the same rationale.

In regard to independent claim 23, is directed to a computer readable medium for performing the method of claim 1, and is similarly rejected along the same rationale.

In regard to dependent claim 24, is directed to a computer readable medium for performing the method of claim 2, and is similarly rejected along the same rationale.

In regard to dependent claim 25, is directed to a computer readable medium for performing the method of claim 3, and is similarly rejected along the same rationale.

In regard to dependent claim 26, is directed to a computer readable medium for performing the method of claim 4, and is similarly rejected along the same rationale.

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In regard to dependent claim 27, is directed to a computer readable medium for performing the method of claim 5, and is similarly rejected along the same rationale.

In regard to dependent claim 28, is directed to a computer readable medium for performing the method of claim 6, and is similarly rejected along the same rationale.

In regard to dependent claim 29, is directed to a computer readable medium for performing the method of claim 7, and is similarly rejected along the same rationale.

In regard to dependent claim 30, is directed to a computer readable medium for performing the method of claim 8, and is similarly rejected along the same rationale.

5. **Claims 7 and 21**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cariffe US006561422B1 - filed 05/03/1999 (hereinafter Cariffe), in view of Uekusa et al. US005122953A filed 08/30/1989 (hereinafter Uekusa), further in view of Meizei US006070175A - filed 08/26/1997 (hereinafter Meizei).

In regard to dependent claim 7, Cariffe and Uekusa do not explicitly teach, **storing the subsequent version of the online document in a redline format**, however (Meizei at col. 19, lines 30-55, disclose a method, wherein SilentSave enables a user to save a file in a variety of formats), also as taught by Uekusa at col. 13, lines 24-55, discloses a method, wherein collaborating on the Preparation of a Document, illustrating in FIG. 15 is a block diagram of how Redline enhances).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Meizei into Cariffe and Uekusa to provide a way, wherein storing the subsequent version of the online document in a redline format. One of ordinary skill in the art would have been motivated to modify this combination to

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provide an intuitive mechanism for collaborating on preparing a document (e.g. Redline), comprehensive tools for creating data driven graphics, computer-to-computer utilities, graphics and table tools, document reports, filters, and a dynamic interface to database systems for publishing, (as taught by Meizei at col. 3, line 50 through col. 4, line 5), also provide a system, wherein creates handwritten or machine generated subsequent markings on existing documents and accurately and efficiently separates the subsequent markings from the original material and converts at least the subsequent markings into a digital form. The digital form can be computer readable digital information representing the markings, (as taught by Cariffe at col. 3, lines 25-65).

In regard to dependent claim 21, is directed to a system for performing the method of claim 7, and is similarly rejected along the same rationale.

Response to Argument

9. Applicant's Remark filed 05/03/2005 have been fully considered but they are not persuasive. The reason for rejection is set forth in the previous rejection state above and further more of the following:

Reponses to argument claims 1-6, 8-20 and 22-30, Remarks pages 7-9:

Applicant argues that Cariffe fail to teach and/or suggest the limitation such as **inscribing the offline document with one or more editing instructions**. The Office respectfully disagrees, the reason of rejection is set forth in the rejection above. In further support of the current rejection, please note the following: Cariffe at col. 1, lines 10-30, described a word processing application and printed on an inkjet printer may be

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distributed to and reviewed by others for receiving their edits and comments Typically, edits and comments are conveyed by placing edit and comment markings directly on the original document. These additional markings can include interlineations, annotations and other additions. These additional markings, which can be alphanumeric characters or other types of symbols, are usually created by a manual-marking device (handwriting), such as a pencil whichever type of marking device is used to add the markings to the original document, the marking process results in a new document, the concept described here in the broadest reasonable interpretation as claimed (i.e. edits and comments includes a means of include interlineations, annotations and other additions is reasonably equivalent to one or more editing instructions as claimed).

Further more applicants argue that Uekusa fail to teach and/or suggest the limitation such as **editing instructions selected from a predetermined set of editing symbols**. The Office respectfully disagrees, the reason of rejection is set forth in the rejection above. In further support of the current rejection, please note the following: Uekusa at col. 11, lines 5-40 and FIG. 12 sheet 15 of 27, described a method, wherein any train character command to be input when a command-instructed symbol (i.e. formula command list in FIG. 12) is instructed, the concept described here in the broadest reasonable interpretation as claimed (i.e. a command-instructed symbol (i.e. formula command list in FIG. 12) is instructed, is reasonably equivalent to editing instructions selected from a predetermined set of editing symbols as claimed). Please note that the Office implied Uekusa reference to include a means of editing instructions selected from a predetermined set of editing symbols.

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Further more, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Cariffe wherein short hand/markings are placed on the original document for proofreading/edit/review of the original document, then a digital scanning device (OCR) can be used to separate and convert the markings created with the high-contrast marking agent into a digital form to include a means of editing instructions selected from a predetermined set of editing symbols of Uekusa. One of ordinary skill in the art would have been motivated to modify this combination to provide a system, wherein creates handwritten or machine generated subsequent markings on existing documents and accurately and efficiently separates the subsequent markings from the original material and converts at least the subsequent markings into a digital form. The digital form can be computer readable digital information representing the markings, (as taught by Cariffe at col. 3, lines 25-65).

Therefore, the rejection of independent claim 14 is proper, which leads to the rejection of the intervening claims 1, 8, 9, 15, 22, 23, and 30.

Reponses to argument claims 7 and 21, Remarks pages 9-10:

For the same reason set forth above claims 1 and 15 remain rejected, which leads to the rejection of the intervening claims 7 and 21.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (571) 272-4103. The examiner can normally be reached on Monday through Friday from 11AM to 7PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R Heather can be reached on (571) -272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran

Patent Examiner

Technology Center 2176

July 5, 2005

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
7/6/2005